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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------------|------------------|
| 10/718,716 | 11/24/2003 | Atsushi Suzuki | 245698US0 | 9960 |
| 22850 | 7590 | 07/05/2005 | | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER TATE, CHRISTOPHER ROBIN | |
| | | | ART UNIT 1655 | PAPER NUMBER |

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,716

Applicant(s)

SUZUKI ET AL.

Examiner

Christopher R. Tate

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0204 & 0404.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claims 1-2 are presented for examination on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasagawa (JP

06038723 - full English Translation by computer & DWPI Abstract), by Hasagawa (JP

10183164 - full English Translation by computer & JPAB Abstract), by UCC Ueshima (JP

2002285026 - full English Translation by computer & DWPI Abstract), by Tsuruizumi (JP

05236918 - full English Translation by computer & JPAB Abstract), by Osawa (US 4,798,732), by Buchholz et al. (US 5,888,549); and under 35 U.S.C. 102(e) as being anticipated by Chien et al. (US 2003/0003212).

A method (for enhancing mineral absorption) comprising administering an effective amount of green coffee bean extract (to someone/something?) is claimed.

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Each of the cited references teach the administration (e.g., added to a food and/or beverage) of a green (raw) coffee bean extract within the instantly disclosed effective amount range (see, e.g., full computer translations including Detailed Description and Examples - and the corresponding DWPI or JPAB English Abstracts, of the first four cited references; US'409 - col 2, line 6 - col 3, line 41, col 4, lines 43-59, and claims; US '549 - col 3, line 4 - col 4, line 12 col 5, line 31 - col 8, line 48, and claims; '212 - paragraphs [0002], [0008]-[0014], [0025], [0033], [0034]-[0037], Examples, and claims). Please note that the functional effect instantly claimed/disclosed (i.e., enhanced absorption of the natural minerals contained within such foods and/or beverages) would be inherent upon the inevitable consumption (administration) thereof, particularly since the instant specification discloses that an effective amount of green coffee bean extract within such food or beverage compositions can range from 0.01 to 100 wt % (see, e.g., page 9, lines 4-8, of the instant specification).

In addition, please note that, as readily admitted by Applicants, the green coffee bean extract of the present invention is available by the process disclosed by each of the first two cited references above. Accordingly, since the first two cited references expressly teach that their green coffee bean extract preparations are added to food and beverages (within the instantly disclosed amount range), the functional effect instantly claimed/disclosed (i.e., enhanced absorption of the natural minerals contained within such foods/beverages) would be inherent upon the inevitable consumption (administration) thereof.

Therefore, each of the cited references is deemed to anticipate the instantly claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasagawa (JP 06038723 - DWPI Abstract), Hasagawa (JP 10183164 - JPAB Abstract), UCC Ueshima (JP 2002285026 - DWPI Abstract), Tsuruizumi (JP 05236918 - JPAB Abstract), Osawa (US 4,798,732), Buchholz et al. (US 5,888,549), or Chien et al. (US 2003/0003212).

The references are relied upon for the reasons set forth above.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to administer (e.g., to a human) a food and/or beverage containing green (raw) coffee bean extract therein based upon the beneficial teachings provided by each of the cited references with respect to incorporating such green coffee bean extracts therein. Again please note that the functional effect instantly claimed/disclosed (i.e., enhanced absorption of the natural minerals contained within such foods/beverages) would be intrinsic upon the actual consumption (administration) thereof.

Thus, the invention as a whole is prima facie obvious over each of the cited references, especially in the absence of evidence to the contrary.

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Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (571) 272-0970. The examiner can normally be reached on Mon-Thur, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher R. Tate
Primary Examiner
Art Unit 1654